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EXAMINER

WOOD, KIMBERLY T

ART UNIT PAPER NUMBER

3632

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/884,540

Applicant(s)

ODDSEN, ODD N.

Examiner

Kimberly T. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 13, 16, 17, 20, 23-26 and 28-44 is/are rejected.
- 7) ☒ Claim(s) 5, 7-12, 14, 15, 18, 19, 21, 22 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/23/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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This is the third office action for serial number 09/884,540, entitled Configurable Mount For A Peripheral Device, in response to Amendments B filed on May 14, 2003 and Amendment C filed on June 13, 2003.

*Allowable Subject Matter*

The indicated allowability of claims 3, 4, 17, 20, 22, 23, 29, 30, 31, 33-36 is withdrawn in view of the references) to Zerbst )Rejections based on the references) follow.

*Drawings*

The formal drawings filed on July 23, 2002 have been approved by the examiner. The examiner would like to indicate to the applicant that the formal drawings submitted only included figures 1-18. The applicant did not submit formal drawings for the remaining figures 19-30 which illustrate the applicants claimed invention.

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### *Specification*

The specification of the disclosure is objected to because reference character " 24" has been used to designate both walls and receptacle (page 9); reference characters " 26" and " 28" have both been used to designate bottom hole; Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

Claim 31 objected to because of the following informalities: the "An" in line 3 should be --an--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 15 recites the limitation "a pair of spaced pins" in line 2. There is insufficient antecedent basis for this limitation in the claim. The applicant has disclosed at least one pin in a claim 1. The examiner can not determine whether the pair of spaced pins is the at least one pin with an additional pin or a separate pair of pins.

#### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Yogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 13, 16, 17, 20, 23-26, 28-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-79 of copending Application No. 09/406,531 in view of Zerbst 2,062,156. Application "531" discloses a shaft holder, a first member with first and second flanges, a second member with third and fourth flanges, openings/holes, threaded members, clamping plate, and a method of mounting these elements. The "531" application discloses all of the limitations of the claimed invention except for multiple pins and openings/holes corresponding to the pins for receiving the pins. Zerbst teaches that it is known to have a pin (24) on one element (15) and a corresponding hole or opening in an attaching member (13) to receive the pin therefore preventing the element (15) from twisting relative to the attaching member (13). It would have

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been obvious to one having ordinary skill in the art at the time of the invention to have modified "531" to have included a pin on each of the second member third and fourth flanges and a corresponding hole/opening on the first member second flange for the purpose of holding/ and aligning and therefore preventing the twisting (page 2 line 70ff) of the first member to the second member. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included additional pins to the third and fourth flanges of the second member and corresponding additional holes or openings to the first member flange since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art which would produce the expected result of a more secure attachment of the first member to the second member and ensure that the members would not twist relative to one another. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been an obvious matter of design choice to have made the pins non-circular, since such a modification would have involved a mere change in the shape of a component and would not produce any unexpected results or destroy the invention since the applicant has not provided a reason for why the pin should be non-circular. A change in size or shape is generally

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recognized as being within the level of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 13, 16, 17, 20, 23-26, 28, 29-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Oddsen WIPO 00/25640 in view of Zerbst 2,062,156. Oddsen discloses a shaft holder, a first member with first and second flanges, a second member with third and fourth flanges, openings, threaded members, clamping plate, and a method of mounting these elements. Zerbst teaches that it is known to have a pin (24) on one element (15) and a corresponding hole or opening in an attaching member (13) to receive the pin therefore preventing the element (15) from twisting relative to the attaching member (13). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Oddsen to



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have included the pin to each of the second member third and fourth flange and an opening to the first member flange for the purpose of holding/and aligning and therefore preventing the twisting (page 2 line 70ff) of the first member to the second member. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included a pair pins to the third and fourth flanges of the second member and a pair of holes or openings to the first and second flange since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art which would produce the expected result of a more secure attachment of the first member to the second member and ensure that the members would not twist relative to one another. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been an obvious matter of design choice to have made the pins non-circular, since such a modification would have involved a mere change in the shape of a component and would not produce any unexpected results or destroy the invention since the applicant has not provided a reason for why the pin should be non-circular. A change in size or shape is generally recognized as being within the level of ordinary skill in the art.

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**Allowable Subject Matter**

Claims 5, 7-12, 14, 15, 18, 19, 21, 22 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for an Official Amendment or Response is (703) 872-9306. The fax number for an Unofficial Amendment or Response is (703) 308-3519.

Kimberly Wood  
Primary Examiner  
September 17, 2003

  
KIMBERLY WOOD  
PRIMARY EXAMINER